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Paper No. 9

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In re Application of: Lynn Y. Shimada
Application No. 09/345,820

Filed: June 30, 1999

For: METHOD AND SOFTWARE ARTICLE
FOR SELECTING ELECTRONIC PAYMENT
OF VENDORS IN AN AUTOMATED
PAYMENT ENVIRONMENT

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition, filed August 14, 2001 under 37 C.F.R. §102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status...;
- (C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
- (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submission is deficient in that it does not comply with (B) and (E) above. With respect to (B), while a statement is found indicating that applicant believes all claims are directed to a single invention, no clear statement is found indicating that applicant would make an election without traverse if the claims are not obviously directed to a single invention. The petition does indicate that applicant "agrees to comply with the other requirements of §1.102(d), such as restriction practice and interviews without traverse" but this paragraph of the rule contains no restriction or interview requirements per se. With respect to (E), while applicant discusses the content of the references and argues that they do not disclose certain features, this discussion does not mention independent claim 9 and mentions a claim 15 that does not appear in the file. Finally, the discussion of the references is not clear with respect to how the features mentioned in the arguments correspond to the claim language as some features mentioned do not appear in the claims and it is not clear how each independent claim is covered by the arguments presented.

Accordingly, the Petition is **DENIED**. The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date.

Any request for reconsideration must be filed within two months of the mailing date of this decision.



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